

17 DEC 2007



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|                                    |   |          |
|------------------------------------|---|----------|
| In re Application of               | : | DECISION |
| MURUYAMA et al.                    | : |          |
| Application No.: 09/890,799        | : |          |
| PCT No.: PCT/US99/02445            | : |          |
| Int. Filing Date: 05 February 1999 | : |          |
| Priority Date: None                | : |          |
| Attorney Docket No.: 58086.244181  | : |          |
| For: THERMO-REVERSIBLE POLYMER FOR | : |          |
| INTRALUMENAL IMPLANT               | : |          |

This decision is in response to applicants' "RENEWED PETITION UNDER 37 CFR 1.181 INCLUDING PETITION TO REINSTATE NOTICE OF ACCEPTANCE" filed in the United States Patent and Trademark Office (USPTO) on 26 September 2007.

**BACKGROUND**

On 05 February 1999, applicant filed international application PCT/US99/02445 which designated the US and did not claim a priority date. A copy of the international application was communicated to the USPTO from the International Bureau on 10 August 2000. The thirty-month period for paying the basic national fee in the United States expired at midnight on 06 August 2001 (05 August 2001 being a Sunday).

On 03 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the basic national fee.

On 04 September 2001, a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 12 April 2002, the United States Designated/Elected Office (DO/EO/US) mailed a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) according to the application a 35 U.S.C. § 371(c)(1), (c)(2), and (c)(4) date and a 35 U.S.C. 371 date of 02 January 2002.

On 08 December 2003, a first Office action on the merits was mailed.

On 19 August 2004, applicants filed a petition to revive the application which was accompanied by, *inter alia*, a USPTO postcard receipt date-stamped 30 January 2002 itemizing a declaration of inventors and a copy of a declaration of inventors.

On 17 November 2004, a decision was mailed granting applicants' petition to revive.

On 07 June 2007, applicant submitted a "REQUEST FOR CORRECTED NOTICE OF ACCEPTANCE AND FILING RECEIPT" which was properly treated as a petition under 37 CFR 1.181.

On 12 September 2007, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.181 and vacating the NOTICE OF ACCEPTANCE OF APPLICATION mailed 12 April 2002.

On 26 September 2007, applicants filed the instant "RENEWED PETITION UNDER 37 CFR 1.181 INCLUDING PETITION TO REINSTATE NOTICE OF ACCEPTANCE" which was accompanied by, *inter alia*, two declarations of inventors and a copy of a USPTO date-stamped postcard receipt.

### **DISCUSSION**

#### **Petition to Accept Declarations of Inventors**

Applicants have provided sufficient evidence to establish that on 30 January 2002 applicants filed two declarations of inventors. The proof is in the form of the copy of the receipt for the above-identified application which bears a USPTO date stamp of 30 January 2002 and which itemizes "(2)" "Declaration[s]" and identifies the above-captioned application number, docket number, and title. Further, practitioner states that the copy of the declarations filed 26 September 2007 are copies of the declarations originally filed 30 January 2002. Therefore, in view of the date-stamped receipt and practitioner's statement, the declarations received on 26 September 2007 may properly be accepted as originally received in the USPTO on 30 January 2002.

#### **Petition to Reinstate Notice of Acceptance**

The declaration filed 30 January 2002 signed by Yuichi Murayama and Fernando Vinuela is not sufficient because it contains non-initialed alterations. 37 CFR 1.52(c). "The Office will not consider whether noninitialed and or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration." MPEP § 605.04(a). Item I. Both the entry for Yuichi Murayama and the entry for Fernando Vinuela contain non-initialed alterations.

### **CONCLUSION**

For the reasons set forth above, the petition under 37 CFR 1.181 to accept the declarations of inventors filed 26 September 2007 as having originally been received on 30

January 2002 is **GRANTED**.

For the reasons set forth above, the petition under 37 CFR 1.181 to reinstate the NOTICE OF ACCEPTANCE is **DISMISSED** without prejudice.

Applicant is required to submit a proper declaration within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301  
Facsimile: (571) 273-0459